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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,489	10/21/2003	Michael Whitsett	W04-1041	5078
27257 7590 04/29/2008 KEATY PROFESSIONAL LAW CORPORATION THOMAS S. KEATY 2 CANAL STREET 2140 WORLD TRADE CENTER NEW ORLEANS, LA 70130				
EXAMINER				
SAFAVI, MICHAEL				
ART UNIT		PAPER NUMBER		
3637				
MAIL DATE		DELIVERY MODE		
04/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,489

Applicant(s)

WHITSETT, MICHAEL

Examiner

M. Safavi

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Applicant's remarks with regard to Examiner's withdrawal of claims 1-4, 16, and 18-21 as not reading upon the elected species has been noted. However, the specification does not describe the embodiment of Fig. 1C/22 as having "a lowermost helical anchor having an upper, squared end portion, a cylindrical section, a drive shaft and a tapered transition section that joins the shaft to the cylindrical section". The embodiment of helical anchor shown in Fig. 1C/22 does not possess a cylindrical section joined to a shaft by a tapered transition section. The cylindrical section 12 referenced by applicant is not part of the helical anchor. Rather, the cylindrical section 12 is a "hollowed pile section". For example, the language recited in lines 4-5 and 8-10 of original claim 25 does read upon the embodiment of Fig. 1C/22.

Terminal Disclaimer

The terminal disclaimer filed on January 22, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,814,525 has been reviewed and is NOT accepted.

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25, lines 14-15, it is not clear as to what is being defined by "each joint portion between the pile sections adjoining a non-circular surface of an adjacent pile section". Initially, there does not appear to be antecedent basis for "each joint portion between the pile sections". It is therefore, not clear as to what "each joint portion between the pile sections" serves to define. Further, it is not clear as to what is being defined by "joint portions formed by non-circular transition portions". The structure of the joint portion has not been clearly established within the claim. To what, for example, does "non-circular transition portions" of lines 7-8 refer? It is not clear as to what "non-circular transition portions" of lines 7-8 serves to define. Would these "non-circular transition portions" have anything to do with any or each "non-circular transition portion" recited in line 6 of claim 25? Therefore, it is not clear as to what a "joint portion" serves to define. For example, how does a "joint portion" adjoin "a non-circular surface of an adjacent pile section"? Meanwhile, line 17 recites "non-circular surfaces" when it is not clear as to what "non-circular surfaces" of line 17 refers. Would these be the same as "non-circular transition portions" recited in lines 7-8?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 23, and 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Turzillo '657 in view of Fujita.

Turzillo '657 discloses, Fig. 1, an pile apparatus 10 having "torque receiving" substantially cylindrical hollowed pile sections 11 with a lowermost pile section connectable to an upper end portion of helical anchor 11/19/20, and an internal rotary drive system formed of sections 16 connectable end to end and which fit within the pile sections with the drive including enlarged members 18 that fit at joints 12 between respective pile sections thus, "a rotary drive means for transmitting rotational force to the pile sections and the anchor, said drive means comprising drive members that fit inside end portions of the pile sections". The drive members 18 can be seen as fit inside end portions of the pile sections", (see Fig. 1 for example). As for claim 25, Turzillo discloses a connection means for connecting a lower portion of a pile segment 11 to an upper end of the anchor 11/19/20, col. 2, lines 8-10.

Turzillo does not appear to specifically present 1) a pile apparatus having two or more pile segments together with the lowermost anchor, (Turzillo showing only one pile segment 11 connected to the anchor 11/19/20 while not explicitly teaching use of two or

more pile segments 11), nor 2) ends of the pile segments so as to form a non-annular or squared joint connection.

However, **1)** Turzillo discloses use of a requisite number of pile sections 11, col. 2, lines 5-9 and **2)** Fujita teaches forming pile sections of a circular or square cross sectional shape, Fig. 1 and Figs. 7 and 10 with upper pile segments fitting within lower pile segments.

Therefore, **1)** to have provided the Turzillo '657 pile system 10 with any number of pile sections 11, as for example three or more sections including two or more spaced joint positions, (with the lowermost section possessing a helical anchor 11/19/20), thus accounting for any depth of hole required, as well as **2)** form the ends of the pile segments so as to form a squared joint connection, thus realizing an effective resistance to compression or buckling, would have constituted an obvious expedient to one of ordinary skill in the art as taught by the Turzillo '657 disclosure in view of Fujita. With such a modification the Turzillo '657 pile apparatus would possess a non-annular or squared joint.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,814,525. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the piling art to provide the drive of the invention of claims 1-19 of U.S. Patent No. 6,814,525 as a "rotary drive having means for transmitting rotational force" as well as provide the helically threaded portion of the invention of claims 1-19 of U.S. Patent No. 6,814,525 as a "helically threaded vane portion".

Claims 25-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19, (particularly, claims 3 and 8), of U.S. Patent No. 6,814,525. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the piling art to provide the drive of the invention of claims 1-19, (particularly, claims 3 and 8), of U.S. Patent No. 6,814,525 as a "rotary drive having means for transmitting rotational force" as well as provide the helically threaded portion of the invention of claims 1-19, (particularly, claims 3 and 8), of U.S. Patent No.

6,814,525 as a "helically threaded vane portion" as well as provide the pile sections of the invention of claims 1-19, (particularly, claims 3 and 8), of U.S. Patent No. 6,814,525 as "generally cylindrical pile sections".

Response to Arguments

Applicant's arguments filed January 22, 2008 have been fully considered but they are not persuasive. Turzillo '657 does disclose an anchor as at 11/19/20. Applicant's remarks within lines 2-9 on page 8 of the response do not appear commensurate with the scope of the invention defined by the language of he rejected claims. In any event, it is not seen that Turzillo cannot receive tensile load carrying capacity from the helical anchor and compressive load carrying capability from the hollow pile sections. Turzillo's pile sections can be filled with grout or concrete filler or the like. Further, Turzillo's large diameter hollow pile sections are strong in compression even if they are not filled with a filler material.

With regard to Fujita, one having ordinary skill in the pile driving art would realize that providing for a square end to end connection would impart an effective resistance to compression or buckling as well as allow for uniform application of torque as by having a joint that effectively inhibits rotation between the pile sections. As decided by *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), a claim would be found obvious if the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. The court also found that a claim would

be obvious if "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success it is likely the product not of innovation but of ordinary skill and common sense". In the instant case, one having ordinary skill in the pile driving art would realize that providing for a square end to end connection would impart an effective resistance to compression or buckling as well as allow for uniform application of torque as by having a joint that effectively inhibits rotation between the pile sections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Safavi/
Primary Examiner, Art Unit 3637

M. Safavi
April 16, 2008